

-2-

REMARKS

The Examiner has objected to Claim 5 due to informalities. Applicant respectfully explains that the number '4' in Claim 5 was correctly struck out, but that the strike out is simply not visible in the claim due to the font of the '4'. Thus, no correction is required.

The Examiner has rejected Claims 10, 14-15, 20, and 24-25 under 35 U.S.C. 102(e) as being anticipated by Henrie (U.S. Patent No. 6,804,699). The Examiner has further rejected Claims 1, 3, 5-9, 16, 19, 26, 28-29, 31 and 33-38 under 35 U.S.C. 103(a) as being unpatentable over Odagiri (U.S. Patent No. 2001/0007817) in view of Henrie. Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, the Examiner has relied on the following excerpt to make a prior art showing of applicant's claimed, "wherein when the device is at least partially non-functional, the device is configured to continue periodically sending the identifying signal to the control unit" (see the same, or substantially similar, claim language in claims 1 and 29), "locking out the first Bluetooth-enabled device to at least partially prevent the first Bluetooth-enabled device from functioning if it is determined that the second Bluetooth transmission signal is not received, wherein the first Bluetooth-enabled device periodically emits the first Bluetooth transmission signal while being locked out" (see the same, or substantially similar, claim language in claims 10 and 20), and "wherein after the generation of the alarm, the second Bluetooth-enabled device is configured to continue periodically emitting the first Bluetooth transmission signal to the first Bluetooth-enabled device" (see the same, or substantially similar, claim language in claims 16 and 26):

"Alternatively, Web site 40 can respond to portable computer system 100 with an indication that the device is not lost or stolen, where this indication is necessary in order for portable computer system 100 to operate normally. In one embodiment, the user can configure portable computer system 100 such that it is necessary for the device to make contact with Web site 40 on a periodic basis, at an interval specified according to user

-3-

preferences. If the specified time period expires before portable computer system 100 connects with Web site 40, then the device is automatically disabled. For example, the authorized user could specify that portable computer system 100 is to connect with Web site 40 once per week, and if a week goes by without such a connection, then portable computer system 100 is disabled. If, at a later time, the authorized user attempts to use portable computer system 100, then portable computer system 100 can still be connected to Web site 40 (this capability remains even if the device is in the disabled or locked mode). After looking up the account information based on the unique identity of portable computer system 100 (step 945) to determine whether the device has been lost or stolen, Web site 40 sends a signal to the device that unlocks the device and enables normal operation. It is appreciated that other actions may need to be performed in order to re-enable operation of the device.

In step 960, if portable computer system 100 is reported as lost or stolen, then Web site 40 sends a signal to the device indicating that normal operation of the device is disabled. As described above, disabling operability of the device can be the result of a signal received from Web site 40 or it can be a default setting if no response is received to the signal of step 930. In addition, if portable computer system 100 has been reported as lost or stolen and has already been disabled in accordance with the present invention, it will continue to remain disabled as a result of this step. For example, if portable computer system 100 is in the locked mode, and no response is received in step 960, then it will continue to remain in the locked mode." (Col. 11, lines 28-65-emphasis added)

Applicant respectfully asserts that the above excerpt from Henrie does not meet applicant's above cited claim language, and in fact teaches away from applicant's claim language. Specifically, Henrie teaches "that it is necessary for the device to make contact with Web site 40 on a periodic basis...If the specified time period expires before portable computer system 100 connects with Web site 40, then the device is automatically disabled." (see emphasized excerpt above) Thereafter, only when "the authorized user attempts to use portable computer system 100, then portable computer system 100 can still be connected to Web site 40..." (see emphasized excerpt above)

Thus, in Henrie, when the portable computer system does not connect to the web site within a specified period of time at periodic intervals, the system is disabled, and the portable computer system can only connect to the Web site when an authorized user attempts to use the portable computer system. Applicant, on the other hand, claims continuing to periodically send identifying signals to the control unit even when the

-4-

device is partially non-functional, locked out, or when an alarm has been generated, as in the following claim language: “wherein when the device is at least partially non-functional, the device is configured to continue periodically sending the identifying signal to the control unit” (Claims 1 and 29), wherein the first Bluetooth-enabled device periodically emits the first Bluetooth transmission signal while being locked out” (Claims 10 and 20), and “wherein after the generation of the alarm, the second Bluetooth-enabled device is configured to continue periodically emitting the first Bluetooth transmission signal to the first Bluetooth-enabled device” (Claims 16 and 26). Therefore, Henrie clearly teaches away from applicant’s claim language.

With respect to the 102(e) rejection, the Examiner is reminded that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

With respect to the 103 rejection, the Examiner is reminded that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

The criteria required by both the 102(e) and 103 rejections have simply not been met since the Henrie reference fails to teach every element of applicant’s claim language, as noted above. Specifically, with respect to the 103 rejection, at least the third element

-5-

of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above.

A notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested. Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to dependent Claim 7, the Examiner has relied on the following excerpt from Odagiri to meet applicant's claimed, "wherein the control unit is configured to produce an alert when it is determined that the device is not within the range of communications of the control unit":

"...and alert means for performing alerting with respect to the reception of the signal by the first receiving means depending upon the result of the determination made by the decisions means." ([0013])

Applicant respectfully asserts that Odagiri teaches alerting "with respect to the reception of the signal", and not "when it is determined that the device is not within the range of communications of the control unit", as claimed by applicant. Specifically, sending an alert based on whether a signal is received does not even suggest sending an alert based on "whether the device is not within the range of communications of the control unit."

With respect to dependent Claims 8, and 9, the Examiner has relied on the following excerpt from Odagiri to meet applicant's claimed, "wherein the control unit includes a display, the display being configured to display information associated with the device when it is determined that the device is not within the range of communications of the control unit" (Claim 8) and "wherein the device includes a display, the display being configured to display information associated with the control unit when it is determined that the device is not within the range of communications of the control unit" (Claim 9):

"The decision section 404 makes a determination as to whether the reply signal is received by the receiving section

-6-

303, as does the decision section 304 shown in FIG. 3. The alert section 405 corresponds to one possible form of the processing operation control section 305 shown in FIG. 3. When the first receiving section 401 receives a signal, the alert section 405 informs the possessor (user) of the reception of the signal by the first receiving section 401 depending upon the result of the determination made by the decision section 404. A method for this signal reception information is, for example, a method of displaying data in the form of characters, an image or the like through the display section 207 shown in FIG. 2, or a method of outputting a predetermined signal, sound, speech or the like through the speaker 204." ([0063]-emphasis added)

Applicant respectfully asserts that Odagiri teaches displaying signal reception information, "when the first receiving section 401 receives a signal" (see emphasized excerpt above), and not "when it is determined that the device is not within the range of communications of the control unit" (Claims 8 and 9-emphasis added) as claimed by applicant. In addition, Odagiri only teaches "inform[ing] the possessor (user) of the reception of the signal" whereas applicant claims "wherein the control unit includes a display, the display being configured to display information associated with the device..." (Claim 8-emphasis added).

Again, a notice of allowance or a specific prior art showing of each of the foregoing limitations, in combination with the remaining claim elements, is respectfully requested.

Reconsideration is respectfully requested.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. Applicants are enclosing a check to pay for the added claims. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NA11P312).

Respectfully submitted,

Zilka-Kotab, PC

Kevin J. Zilka

-7-

Registration No. 41,429
P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100